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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,045	05/01/2001	Philip Ted Kortum	8285/431	5221

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,045

Applicant(s)

KORTUM, PHILIP TED

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 5-7, 8, 12-15, 16 and 20 rejected under 35 U.S.C. 102(a) as being anticipated by “SBC global network DSL: Customer Self Install” (Document), which appears to be published on August, 2000.

The Document teaches customer self installation DSL kit and method of installing thereof, comprising:

Independent Claims.

As per **claim 1**,

- a digital subscriber line modem (page 4);
- at least one digital subscriber line filter (page 1);
- a computer-readable medium whose contents comprise computer-readable connection software code (pages 1, 5, 8 and 9);
- at least one instruction manual which describes a unified installation process for the digital subscriber line modem, a network card, and the at least one digital subscriber line filter (pages 3 and 5);
- the computer-readable connection software code (pages 3 and 5), wherein said at least one instruction manual correspond to an operating system of the user (pages 1, 5, 8 and 9).

As per **claims 8 and 16**,

- a network card (page 4);
- a digital subscriber line modem (page 4);

Art Unit: 3629

- at least one digital subscriber line filter (page 1);
- a computer-readable medium whose contents comprise computer-readable connection software code; (pages 1, 5, 8 and 9);
- a plurality of instruction manuals, including an instruction manual which describes a unified installation process for the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer-readable connection software code, wherein the unified installation process requires at most one operating system selection step by a user (pages 3 and 5). The method step of "selecting a first instruction manual from a plurality of instruction manuals" is inherently indicated in the Document.

Dependent Claims.

As per **claims 5-7, 12-15 and 20**, said kit and method, wherein the instruction manual provides a point of contact telephone number associated with the digital subscriber line modem, the digital subscriber line filter or the computer-readable connection software code (pages 3, 5 and 10).

As per **claims 21**, see **claim 8**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Dependent claims 3-4, 10-11 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Document.

As per **claims 3-4, 10-11 and 18-19**, said Document teaches all the limitations of **claims 3-4, 10-11 and 18-19**, except the container, which contains said kit.

Art Unit: 3629

Official notice is taken that it is well known to provide goods ordered by customers in shipping containers.

Therefor, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Document to include the container, because the container would protect the contents of the kit from damage or from being lost.

Response to Arguments.

In response to applicant's argument that the Document fails to disclose "using" or "not using" of an operating system selection step, the examiner points out that the Document, does, in fact, disclose this feature (See: pages 1, 5, 8 and 9).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306

[Official communications; including After Final
communications labeled "Box AF"]

Application/Control Number: 09/847,045

Page 5

Art Unit: 3629

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600